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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,090	02/20/2004	Henry W. Bonk	402200003DVC	6886

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EXAMINER	
AUGHENBAUGH, WALTER	
ART UNIT	**PAPER NUMBER**
1794	
MAIL DATE	**DELIVERY MODE**
09/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,090	BONK ET AL.	
	Examiner	Art Unit	
	WALTER B. AUGHENBAUGH	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claims 1 and 4 in the Amendment filed June 19, 2008 have been received and considered by Examiner.

WITHDRAWN REJECTION

2. The 35 U.S.C. 112, second paragraph, rejection of claims 1 and 4 has been withdrawn due to Applicant's amendments in claims 1 and 4.

REPEATED REJECTIONS

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 25 of U.S. Patent No. 5,952,065. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 25 of Mitchell et al. falls within the scope of Applicant's claimed invention. See col. 18, lines 45-64. Col. 9, lines 23-25 and col. 14, line 66-col. 15, line 14 show that Applicant's claim terminology "thermoplastic polyurethane" (line 5 of claim 1) includes polyurethane thermoplastic elastomers.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchell et al. (USPN 5,952,065).

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In regard to claim 1, claim 25 of Mitchell et al. reads on Applicant's claimed invention (col. 18, lines 45-64, col. 9, lines 23-25 and col. 14, line 66-col. 15, line 14 [Applicant's terminology "thermoplastic polyurethane" includes polyurethane thermoplastic elastomers]).

In regard to claim 2, a cushioning device having a first layer having an amount of polyurethane that falls within the range recited in claim 2 falls within the scope of claim 25 of Mitchell et al. (claim 25).

In regard to claim 3, Mitchell et al. teach that the materials recited in claim 3 are suitable materials for the second layer (col. 9, lines 31-41).

In regard to claim 4, Mitchell et al. teach thickness ranges for the respective layers that overlap with those recited in claim 4 (col. 5, lines 62-65 and col. 15, lines 23-50).

In regard to claim 5, Mitchell et al. teach that the device comprises nitrogen as a capture gas constituent (col. 2, lines 22-67).

In regard to claim 6, a cushioning device having a first layer having an amount of polyurethane that falls within the range recited in claim 6 falls within the scope of claim 25 of Mitchell et al. (claim 25).

In regard to claim 7, Mitchell et al. teach the EVOH claimed in claim 7 (col. 9, lines 52-66).

In regard to claim 8, Mitchell et al. teach that the first layer includes an aromatic thermoplastic polyurethane (col. 9, lines 52-66).

In regard to claim 9, a cushioning device having a first layer having amounts of polyurethane and EVOH that falls within the range recited in claim 9 falls within the scope of claim 25 of Mitchell et al. (claim 25).

In regard to claim 10, Mitchell et al. teach a cushioning device having the third layer as claimed (col. 12, lines 24-38 and col. 9, lines 31-41).

Response to Arguments

7. Applicant's arguments regarding the obviousness double patenting rejection of claim 1 as being unpatentable over claim 25 of U.S. Patent No. 5,952,065 have been fully considered but are not persuasive.

A blend of aliphatic thermoplastic polyurethane and EVOH falls within the scope of claim 25 of U.S. Patent No. 5,952,065 because a mixture of "polyurethane based thermoplastics" and EVOH falls within the scope of the claim, and since aliphatic thermoplastic polyurethane falls within the scope of "polyurethane based thermoplastics".

While ISOPLAST^{TM} and PELLETHANE^{TM} may be different materials, both fall within the scope of the recitation "polyurethane based thermoplastics".

A mixture of aliphatic thermoplastic polyurethane and EVOH that includes up to about 50 wt. % of the aliphatic thermoplastic polyurethane falls within the scope of the claim recitation of a mixture of the two materials.

Applicant's discussion regarding alleged unexpected results is not persuasive because it is not apparent that Applicant's discussion compares layers of the instant application with layers of U.S. Patent No. 5,952,065 which have the same thicknesses, which would be required to show any benefit of the two layers of the instant application over that of the three layers of U.S. Patent No. 5,952,065 identified by Applicant.

8. Applicant's arguments regarding the 35 U.S.C. 102(e) rejection of claims 1-10 as being anticipated by Mitchell et al. (USPN 5,952,065) have been fully considered but are not persuasive.

U.S. Patent No. 5,952,065 teaches a blend of aliphatic thermoplastic polyurethane and EVOH because a mixture of "polyurethane based thermoplastics" and EVOH falls within the scope of the claim, and since aliphatic thermoplastic polyurethane falls within the scope of "polyurethane based thermoplastics". A mixture of aliphatic thermoplastic polyurethane and EVOH that includes up to about 50 wt. % of the aliphatic thermoplastic polyurethane falls within the scope of the claim recitation of a mixture of the two materials.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /
Examiner, Art Unit 1794

9/12/08

/Rena L. Dye/
Supervisory Patent Examiner, Art Unit 1794